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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,687	08/03/2001	Mathew B. Stanczak	DSCK-1201-C1	6645

7590

06/16/2004

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EXAMINER

ABDELWAHED, ALI F

ART UNIT	PAPER NUMBER
3712	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/890,687

Applicant(s)

STANCZAK ET AL.

Examiner

Ali Abdelwahed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 15-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 26-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/27/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

Claims 4, 7, 14, 28, 29, 33, and 34 are objected to because of the following informalities:

It is suggested that in:

Claim 4, line 1, after "...wherein the..." insert --core--.

Claim 7, line 2, after "...thickness..." delete "of".

Claim 14, line 1, after "...wherein..." delete "the" and insert --a--.

Claims 28 and 33, lines 2, 4, and 6, delete "set" and insert --pattern--.

Claims 29 and 34, lines 2, 4, and 8, delete "set" and insert --pattern--.

Appropriate correction is required.

Claim 35 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 35 is a duplicate of claim 31.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14, and 26-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 8, 11, 13, and 26 recite the limitation "the outer surface". There is insufficient antecedent basis for this limitation in the claims.

Claim 30 recites the limitations "said thread windings layer" and "the outer surface" in lines 4 and 8. There is insufficient antecedent basis for these limitations in the claim.

Claims 31 and 35 recite the limitation "the outer surface" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claims.

Claim 32 recites the limitation "the thread " in line 1. There is insufficient antecedent basis for this limitation in the claim.

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Claim(s) 2-7, 9, 10, 12, 14, 27-29, 33, and 34 depend from rejected claim(s) 1, 26, and 30, respectively, and include all of the limitations of claim(s) 1, 26, and 30 thereby rendering these dependent claim(s) indefinite.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4, 5, and 7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,428,428 B1 to Kuttappa et al. in view of U.S. Patent No. 5,725,442 to Higuchi et al. The claims of Kuttappa et al. cover the claimed subject matter of the present invention except for the limitations comprising the center having a diameter in the range of about 1.34 to about 1.37 inches, and the cover having a thickness in the range of about 0.052 to about 0.063 inches. However, Higuchi et al. teaches a golf ball comprising the aforementioned limitations (see column 3, lines 15-16 and 61-62). Therefore, it would have been obvious to one having ordinary skill in the art at the time

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the invention was made to modify the golf ball of Kuttappa et al., in view of Higuchi et al., such that it would provide the golf ball of Kuttappa et al. with the aforementioned limitations for the purpose of enhancing the performance of the golf ball without compromising shot-making feel of the ball.

Claims 1, 3, 4, and 5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,428,428 B1 to Kuttappa et al. in view of U.S. Patent No. 5,807,192 to Yamagishi et al. The claims of Kuttappa et al. cover the claimed subject matter of the present invention except for the limitation comprising the core having a weight in the range of about 34.5 to 35.5 grams. However, Yamagishi et al. teaches a golf ball comprising the aforementioned limitation (see fig.1, and column 2, lines 39-40). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the golf ball of Kuttappa et al., in view of Yamagishi et al., such that it would provide the golf ball of Kuttappa et al. with the aforementioned limitation for the purpose of enhancing the performance of the golf ball without compromising shot-making feel of the ball.

Claims 1, and 4-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,428,428 B1 to Kuttappa et al. in view of GB 2 264 302 A to Pocklington. The claims of Kuttappa et al. cover the claimed subject matter of the present invention

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except for the limitation comprising the cover comprising a blend of a high resilience ionomer and a very low modulus ionomer being a terpolymer of ethylene, n-butyl acrylate, and methacrylic acid. However, Pocklington teaches a golf ball comprising the aforementioned limitation (see claims 7 and 8). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the golf ball of Kuttappa et al., in view of Pocklington, such that it would provide the golf ball of Kuttappa et al. with the aforementioned limitation for the purpose of enhancing the performance of the golf ball without compromising shot-making feel of the ball.

Claims 1, 7-14, and 30-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of U.S. Patent No. 6,719,646 B2 to Calabria et al. in view of U.S. Patent No. 5,807,192 to Yamagishi et al. The claims of Calabria et al. cover the claimed subject matter of the present invention except for the limitations comprising the cover having a shore D hardness in the range of about 63 to 69, and the core having a weight in the range of about 27.5 to 28.5 grams. However, Yamagishi et al. teaches a golf ball comprising the aforementioned limitations (see fig.1, and column 2, lines 39-40 and 43-45). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the golf ball of Calabria et al., in view of Yamagishi et al., such that it would provide the golf ball of Calabria et al. with the aforementioned limitations for the purpose of enhancing the performance of the golf ball without compromising shot-making feel of the ball.

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Claims 26-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of U.S. Patent No. 6,719,646 B2 to Calabria et al. in view of U.S. Patent No. 5,807,192 to Yamagishi et al. and GB 2 264 302 A to Pocklington. The claims of Calabria et al. cover the claimed subject matter of the present invention except for the limitations comprising the center having a compression in the range of about 60-80 PGA, the cover having a shore D hardness in the range of about 63 to 69, and a high and low modulus ionomer, and a terpolymer. However, Yamagishi et al. teaches a golf ball comprising the center having a compression in the range of about 60-80 PGA, and the cover having a shore D hardness in the range of about 63 to 69 (see fig.1, and column 2, lines 24-26 and 43-45); and Pocklington teaches a golf ball comprising a high and low modulus ionomer, and a terpolymer (see claims 7 and 8). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the golf ball of Calabria et al., in view of Yamagishi et al. and Pocklington, such that it would provide the golf ball of Calabria et al. with the aforementioned limitations for the purpose of enhancing the performance of the golf ball without compromising shot-making feel of the ball.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Abdelwahed whose telephone number is (703) 305-3311. The examiner can normally be reached Monday through Friday from 9:00 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

AA

06/10/2004

A handwritten signature in black ink, appearing to read 'D. H. Banks', with a long horizontal line extending to the right.

**DERRIS H. BANKS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**